

REMARKS

Summary of the Office Action

In the Office Action, claims 1-10, 16, 18-21, and 31-33 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,554,094 to *Viens*.

In the Office Action, claim 11 stands rejected under 35 U.S.C. §103(b) as allegedly being unpatentable over U.S. Patent No. 5,554,094 to *Viens*.

Applicant respectfully traverses these rejections for the following reasons.

Summary of the Response to the Office Action

Applicant amends independent claims 1, 11, 16, 31 and 33-35 to better clarify the invention and cancels claim 3. Accordingly, claims 1, 2-11, 16, 18-21, and 31-35 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 102(b)

In the Office Action, claims 1-10, 16, 18-21, and 31-33 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,554,094 to *Viens*. Applicant respectfully traverses the rejections for the following reasons.

Viens does not anticipate the present invention at least because *Viens* does not teach or suggest all the recited features of newly amended independent claims 1, 16, and 33. Namely, *Viens* does not teach or suggest at least “a sheet folding unit which applies folding on a sheet as the sheet proceeds along a single sheet path; and an auto-folding mode selecting device which selectively causes the sheet folding unit to operate one of a plurality of folding modes including at least letter C-folding, letter Z-folding, and Z-folding,” features recited in newly amended claims 1, 16, and 33.

Viens does not disclose “an auto-folding mode selecting device” that “selectively causes the sheet folding unit to operate one of a plurality of folding modes.” That is, there is no folding mode selecting device because *Viens* teaches that an operator or user manually changes each folding apparatus 12 to perform either Z-folding, C-folding, or half-folding of sheets. See at least col. 4, line 61 through col. 5, line 8 of *Viens*. The user cannot be the equivalent of an auto-folding mode selecting device.

Viens actually discloses three separate sheet folding apparatus 12 that have different folding sheet paths. Each sheet folding apparatus 12 can be exchanged to perform Z-folding, C-folding, and half-folding of sheets. The different sheet paths are shown in Figs. 5A-5B, 6A-6B, and 7A-7B, respectively. The sheet folding apparatus 12, and hence their sheet paths, are manually exchanged from one to another. See col. 1, lines 65-67; col. 4, line 61 through col. 5, line 8; col. 6, lines 29-35; and col. 8, lines 48-52 of *Viens*. Thus, *Viens* teaches away from the present invention because *Viens* discloses sheet folding apparatus 12 with different sheet paths that must be manually exchanged to enable the Z-folding, C-folding, and half-folding of sheets. See col. 4, line 61 through col. 5, line 8; col. 5, line 9 through col. 8, line 30; and Figs. 5A-5B, 6A-6B, and 7A-7B of *Viens*.

In the present invention, the letter Z-folding, letter C-folding, and Z-folding of sheets require only a single configured sheet path. See at least page 12, lines 21-24 of the specification. All three types of sheet folding can be accomplished with one single sheet path configuration as seen in Fig. 3 of the specification. No alternate sheet paths are necessary and no manual exchange of parts is needed to accommodate the different folding modes of the present invention.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Viens* does not teach or suggest each feature of newly amended independent claims 1, 16, and 33.

Additionally, Applicant respectfully submits that dependent claims 2, 4-10, 18-21, and 31-32 are also allowable insofar as they recite the patentable combinations of features recited in newly amended claims 1, 16, and 33, as well as reciting additional features that further distinguish over the applied prior art.

Newly Amended independent claims 34 and 35, which were not mentioned in the Office Action, are also allowable at least because they recite the same patentable combination of features above-mentioned.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claim 11 stands rejected under 35 U.S.C. § 103(a) as obvious over *Viens*. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness and therefore all rejections under 35 U.S.C. § 103(a) should be withdrawn.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. All three criteria must be met to establish obviousness.

As demonstrated above, the Office Action has not established a *prima facie* case of obviousness at least because *Viens* does not teach or suggest all the recited features of newly amended independent claim 1. As pointed out in M.P.E.P. § 2143.03, "[t]o establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art". *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met.

Applicant respectfully asserts that independent claim 1 is distinguishable over the applied art. Therefore, claim 11 which depends from independent claim 1 is allowable at least because claim 1 is allowable, as well as for the additional features recited therein.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: Mary Jane Boswell
Mary Jane Boswell
Reg. No. 33,652

Dated: January 19, 2006

Customer No. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, DC 20004
Tel: 202-739-3000